The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JURGEN KOCH,
LEANDER STAAB, WOLFGANG KOHLWEILER
and KARL-ANTON STARZ

Appeal No. 2002-2031
Application 09/115,553

ON BRIEF

Before WARREN, KRATZ and TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief, and based on our review, find that we cannot sustain any of the grounds of rejection: claims 1 through 5, 9, 11 through 13 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Conn in view of Kawashima et al. (Kawashima); claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Conn in view of Kawashima, as applied to claims 1 through 5, 9, 11 through 13 and 16, further in view to applicants' admissions (specification, page 7, lines 1-10); claims 7, 8 and 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Conn in view of Kawashima and applicants' admissions (specification, page 7, lines 1-10), as

applied to claims 1 through 6, 9, 11 through 13 and 16, further in view of published European Patent Application EP 0 512 489 to Ogura et al.;[1] and claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Conn in view of Kawashima, as applied to claims 1 through 5, 9, 11 through 13 and 16, further in view to applicants' admissions (specification, pages 2-4).[2,3]

We have considered with respect to each ground of rejection *only* the references which appear in the statement of that ground of rejection, as set forth above, and *none* of the additional references on which the examiner relies in addressing appellants' arguments (answer, pages 7 and 8). *See In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); *compare Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993).

There is no dispute that the claimed soldering paste for hard-soldering and coating parts made of aluminum and/or aluminum alloy encompassed by appealed claim 1 differs from the hard-soldering paste for the same materials of Conn by the addition of one or more fatty acids of 10 to 20 carbon atoms, or ammonium salts thereof, and that the examiner contends that, *prima facie*, one of ordinary skill in this art would have been motivated to add such fatty acids and/or ammonium salts to the paste of Conn by Kawashima in disclosing the same viscosity control agents in a tin-lead alloy solder paste. Appellants argue that *prima facie* obviousness has not been established in each of the grounds of rejection because one of ordinary skill in this art would not have combined Conn and Kawashima because of the differences in the components and application conditions, including substrate and temperature, of the respective pastes (brief and reply brief in entirety). In response, the examiner contends that the references are directed to soldering compositions and thus are analogous prior art, and that there is no evidence in the record that the selection of a viscosity control agent is dependent on the application temperature of the soldering paste (answer, e.g., page 7).

In order to establish a *prima facie* case of obviousness, the examiner must show that some objective teaching or suggestion in the applied prior art taken as a whole and/or knowledge

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[1] Ogura '489 is in the same family of patents as United States Patent No. 5,173,126, issued December 22, 1992, to Ogura et al.

[2] Claim 14 is also of record and has been withdrawn from consideration by the examiner under 37 CFR § 1.142(b). Claims 1 through 16 are all of the claims in the application. A copy of the claims on appeal appears in the appendix to the brief.

generally available to one of ordinary skill in this art would have led that person to the claimed invention as a whole, including each and every limitation of the claims, without recourse to the teachings in appellants' disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). The requirement for objective factual underpinnings for a rejection under § 103(a) extends to the determination of whether the references can be combined. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002), and cases cited therein.

In this instance, the examiner has failed to specifically address appellants' contentions that there is *no* similarity between the components of the soldering paste of Conn and of Kawashima, and that the respective prior art pastes are used for entirely different purposes. Thus, we find on the record no reason why one of ordinary skill in this art would have considered adding a fatty acid or ammonium salt thereof to the soldering paste for aluminum and/or aluminum alloy materials of Conn even though Kawashima discloses that this material is a viscosity modifier in tin-lead alloy solder pastes. Indeed, we find that the mere fact that Conn and Kawashima are globally related because each involves a "soldering paste" would not have suggested to one of ordinary skill in this art that Kawashima is reasonably pertinent to the problem of viscosity control of soldering pastes for aluminum and/or aluminum alloy materials as disclosed in Conn, and thus would not have provided both the reasonable suggestion and the expectation of success to use the fatty acids and ammonium salts thereof to solve that problem. *See, e.g.*, *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is

[3] Answer, pages 3-5.

reasonably pertinent to the problem the invention attempts to solve."); *Dow Chem.*, 837 F.2d at 473, 5 USPQ2d at 1531 ("The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. [Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.").

Accordingly, since there is no evidence in the record that one of ordinary skill in this art would have combined the teachings of Conn and Kawashima, we agree with appellants that the examiner has not established a *prima facie* case of obviousness, and therefore, we reverse all of the grounds of rejection which are based on these references.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN Administrative Patent Judge	)	
PETER F. KRATZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CATHERINE TIMM Administrative Patent Judge	)	

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